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10/575,490

02/05/2007

Alfonso Perez Carballo

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SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

NORDMEYER, PATRICIA L

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

05/22/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------------------------|------------------------------------------------|--|
| Office Action Summary | Application No. 10/575,490 | Applicant(s) PEREZ CARBALLO, ALFONSO | |
| | Examiner Patricia L. Nordmeyer | Art Unit 1794 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 16 and 17 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>4/06</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1 - 15, drawn to a non-slip device for personal use items.

Group II, claim(s) 16 and 17, drawn to a manufacturing process for a non-slip device for personal use items.

2. The inventions listed as Groups I do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Claim 1 is either obvious over or anticipated by WO 01/87581 A1. Accordingly, the special technical feature linking the two inventions, non-slip device with an internal cavity, does not provide a contribution over the prior art, and no single general inventive concept exists. Therefore, restriction is appropriate.

3. During a telephone conversation with Raja Silba on May 19, 2009 a provisional election was made with traverse to prosecute the invention of Group I, claims 1 - 15. Affirmation of this election must be made by applicant in replying to this Office action. Claims 16 and 17 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Art Unit: 1794

4. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained.

Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 – 15 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 01/87581 A1.

This rejection is over WO 01/87581 A1 because this reference qualifies as prior art under 35 U.S.C. 102(b). However, for convenience, the column and line numbers of the English language equivalent US Patent Application Publication 2004/0175543 A1 will be cited below.

WO 01/87581 discloses non-slip device for personal use items (Figure 1, #1), comprising a body of elastomeric material (Page 1, Paragraph 0008) with a first side that can be coupled to a surface of a personal use item (Page 1, Paragraph 0008), and a second side opposite to the first one and provided with non-slip properties (Page 1, Paragraph 0008), characterized by the fact that said body comprises a flattened band (Page 1, Paragraph 0008, Figure 1), said band being formed such that once it is adhered to the surface of the personal use item (Page 1, Paragraph 0008), it defines on said surface at least one surface section intended for optionally housing an auxiliary element (Page 2, Paragraph 0027), said surface section being at least partially surrounded by the band (Page 1, Paragraph 0008) as in claim 1. With regard to claim 2, said band has a substantially uniform width (Figure 1). For claim 3, said band forms a closed figure, completely surrounding the surface section of the personal use item (Figure 1). Regarding claim

Art Unit: 1794

4, said second side of the body has a plurality of projections forming one piece with the body (Figure 1, #2'). As in claim 5, the device comprises means of coupling said first side of the body to the surface of the personal use item (Page 2, Paragraph 0019). With regard to claim 6, said means of coupling comprise a strip which is self-adhesive on at least one side and is protected by a removable sheet (Page 2, Paragraph 0019). For claim 7, said strip has a shape that is substantially identical to that of the band (Page 2, Paragraph 0019). Regarding claim 8, said strip encompasses both the band and the surface section of the personal use item which is surrounded by said band (Page 2, Paragraph 0019). As in claim 9, said strip is self-adhesive on both sides (Page 2, Paragraph 0019). With regard to claim 10, said strip has areas with different adhesive properties (Page 2, Paragraph 0019). For claim 11, there is at least one auxiliary element which is housed in the surface section of the personal use item which is surrounded by the band, said auxiliary element being chosen from printed decorative or informative images (Page 2, Paragraph 0027). Regarding claim 12, said auxiliary element has a coating (Page 2, Paragraph 0027, wherein the label would result in a coating). As in claim 13, the coating for the auxiliary object in turn has non-slip properties (Page 2, Paragraph 0027). With regard to claim 14, the auxiliary element is coupled on the strip in the surface section of the personal use item that is surrounded by the band (Page 2, Paragraph 0027). For claim 15, wherein it is incorporated to the personal use item such that it is part of the support surface of said item in a non-removable manner (Page 2, Paragraph 0019).

Art Unit: 1794

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571)272-1496. The examiner can normally be reached on Mon.-Fri. from 10:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R. Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Patricia L. Nordmeyer
Primary Examiner
Art Unit 1794

/Patricia L. Nordmeyer/
Primary Examiner, Art Unit 1794